

REMARKS

This application has been carefully reviewed in light of the Office Action dated June 15, 2004. Claims 1 to 7, 9, 10 and 12 are in the application, of which Claims 1, 7 and 12 are independent. Reconsideration and further examination are respectfully requested.

Claims 1 to 7, 9, 10 and 12 were rejected under 35 U.S.C. § 112, second paragraph, for alleged indefiniteness. The rejection is respectfully traversed.

Specifically, on page 2, the Office Action indicated that the phrase “a decomposable bond” is not defined by Claim 1, in that “the specification does not provide a standard for ascertaining the requisite degree”. Further, the Office Action alleged that the phrases “second component” and “compound having a vinyl group” render Claims 1, 6 and 12 vague and indefinite since Claims 1, 6 and 12 do not point out the identity of the “second component” or “compound having a vinyl group”.

It is believed that the foregoing phrases are sufficiently clear. The plain meaning of a “decomposable bond” is simply a bond between the saccharide component and second component that is able to be decomposed. Pages 10 to 12 of the specification specify that any bond may be used so long as it can be selectively decomposed by an enzyme, and proceeds to provide examples of such decomposable bonds and their respective enzymes.

As for the terms “second component” and “compound having a vinyl group”, these terms are broad but they are not unclear. It is a mistake to equate breadth

with indefiniteness. See MPEP § 2173.04: “breadth of a claim is not to be equated with indefiniteness.”

The Office Action further asserted that the phrase “to the extent” is indefinite because “it is unclear whether the limitation(s) following the phrase are a part of the claimed invention”. Although Applicants disagree with this assertion, in an effort to advance prosecution, Applicants have amended Claims 1, 7 and 12 to replace the phrase “to the extent” with the term “such” to emphasize that any features following the term are part of the claimed invention.

In view of the foregoing, withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, is respectfully requested.

Claims 1 to 7, 9, 10 and 12 were rejected for obviousness-type double patenting over Claims 1, 2, 7, 18, 12 to 15, 20 and 21 of parent patent 6,316,606. This rejection is improper, given the restriction requirement imposed in the parent patent in the Office Action dated August 25, 1998. Although the restriction requirement was traversed, it was made final and adhered to by the Examiner in his Office Action dated November 18, 1998. Accordingly, the double patenting rejection is prohibited under 35 U.S.C. § 121, and should be withdrawn.

No other matters being raised, it is believed that the entire application is fully in condition for allowance, and such action is courteously solicited.

Applicants' undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



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